

REMARKS

Claims 1-32 are pending in this application. Claims 1, 22, and 28 are independent. In light of the amendments and remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

By this Amendment, Applicants have amended the claims to conform to U.S. Patent practice. It is respectfully submitted that these amendments do not affect claim scope, nor do they add any new issues for consideration by the Examiner.

In the outstanding Official Action, the Examiner objected to the drawings and the specification. The Examiner further rejected claims 28-32 under 35 U.S.C. § 102(b) as being anticipated by *Faulkerson* (USP 4,804,949); rejected claims 1-4 and 11-25 under 35 U.S.C. § 103(a) as being unpatentable over *Olschafskie et al.* (USP 5,574,804) in view of *Faulkerson*; and rejected claims 5-10, 26, and 27 under 35 U.S.C. § 103(a) as being unpatentable over *Olschafskie et al.* in view of *Faulkerson*, and further in view of *Saxena et al.* (USP 6,259,449). Applicants respectfully traverse these rejections.

Drawings

In response to the Examiner's objection to the drawings, Applicants submit herewith amendments to the drawings. Based upon these amendments, it is respectfully requested that the outstanding objection be withdrawn.

The Examiner further objected to the specification and requested a substitute specification. By this Amendment, Applicants submit concurrently herewith a copy of the specification. The submission of this copy of the application contains no new matter. Based upon this submission, it is respectfully requested that the outstanding objection be withdrawn.

Claim Rejections - 35 U.S.C. § 102

In support of the Examiner's rejection of claim 28, the Examiner asserts that *Faulkerson* anticipates the claimed invention. Specifically, the Examiner asserts that *Faulkerson* discloses an input unit being arranged to change from the first to the second function mode when the image processor detects a first piece of predetermined information in one of the images, citing to the Abstract and col. 8, lines 17-24. Applicants respectfully disagree with the Examiner's characterization of this reference.

It is respectfully submitted that the disclosure of *Faulkerson* is directed to a hand-held optical scanner and computer mouse. As noted in the Abstract, *Faulkerson* discloses:

A hand-held peripheral device for a computer system or terminal having a video display is disclosed. The device is adapted to operate one of two user-selectable functional modes. In a first mode, the device functions as an optical scanner for image acquisition. In a second mode, the device functions as a computer mouse for controlling the position of a cursor on the video display.

Additionally, at col. 8, lines 17-24, *Faulkerson* discloses:

The function key processor 220 receives data indicative of the status of the various device function keys, and is adapted to perform a look-up function when a particular key is activated by the user to provide a corresponding code at a keyboard port 253 of the computer system 250. The code is user-selected to emulate a predetermined keyboard character, symbol or function key.

As can be seen from the above citations, *Faulkerson* discloses the hand-held peripheral device adapted to operate one of two user-selectable functional modes. These functional modes are selected by the user utilizing the function keys on the hand-held peripheral device. This teaching is also discussed in col. 2, lines 16-23 wherein *Faulkerson* discloses operator controlled function control keys for selectively actuating the optical scanning means or the position transducer. The Examiner's attention is also respectfully directed to col. 6, lines 41-44, wherein *Faulkerson* teaches that the function controls on the device select the device operating mode. At col. 4, lines 38-40, *Faulkerson* discloses device 20 comprising a plurality of camera function keys 26A-26E which are positioned to allow tactile operation by the user. Finally, at col. 7, lines 35-39, *Faulkerson* teaches based on the status of one or more function keys, e.g., whether the OCR or X-Y movement (mouse) function is selected, the processor 220 enables the operation of either the OCR processor 230 or the X-Y position processor 240.

In contrast, the present invention as set forth in claim 28 recites, *inter alia*, an input unit with at least a first and a second function mode comprising a detector for capturing images and an image processor for processing the images to achieve the two functions, wherein the input unit is arranged to change from the first to the second function mode when the image processor detects a first piece of predetermined information in one of the images. As noted above, *Faulkerson* discloses selecting between the two modes utilizing the function keys 26A-26E. Applicants submit that these function keys are insufficient to teach or suggest changing from a first to the second function mode when the image processor detects a first piece of predetermined information in one of the images. There is no teaching or suggestion in *Faulkerson* that discusses detecting predetermined information in an image and changing from the first to the second function mode when a first piece of predetermined information is detected in one of the images. As *Faulkerson* fails to teach or suggest all of the claim elements, it is respectfully submitted that the Examiner has failed to satisfy her burden in establishing *prima facie* anticipation under 35 U.S.C. § 102. As such, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 29-32 are allowable for the reasons set forth above with regard to claim 28 at least based upon their dependency on claim 28.

**Claim Rejections - 35 U.S.C. § 103(a) -
*Olschafskie et al./Faulkerson***

In support of the Examiner's rejection of claim 1, curiously, the Examiner asserts that *Olschafskie et al.* discloses a signal processing unit for identifying predetermined information in at least one of the images and for controlling the electronic device dependent upon the predetermined information, citing to col. 4, lines 20-22, and further asserts that *Olschafskie et al.* discloses an input unit in a first function mode being arranged to convert at least one image to a current text string containing a sequence of characters and that the signal processing unit is arranged to control the electronic device on the basis of the current text string. However, the Examiner fails to provide any citation to the *Olschafskie et al.* reference that teaches or suggests this claim element.

In the next paragraph of the Office Action, the Examiner then admits that *Olschafskie et al.* is silent about an input unit in a first function being arranged to convert at least one image to a current text string containing a sequence of characters and that the signal processing unit is arranged to control the electronic device on the basis of the current text string. The Examiner relies on the teachings of *Faulkerson* to cure the deficiencies of the teachings of *Olschafskie et al.* by asserting that *Faulkerson* teaches this claim element, citing to col. 1, lines 9-21, col. 2,

lines 33-37, and col. 3, lines 30-36. Applicants respectfully disagree with the Examiner's characterization of these references.

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

It is respectfully submitted that the disclosure of *Olschafskie et al.* is directed to a hand-held scanner for reading characters from a string of characters recorded on a substrate. At col. 4, lines 20-22, the portion of the reference the Examiner is relying upon to teach a portion of the claimed invention, *Olschafskie et al.* discloses a series of control buttons 24 provided on top of the scanner 10. One of the buttons 24 is operable to switch the scanner 10 from the character scanning mode to microphone mode.

In contrast, the present invention as set forth in claim 1 recites, *inter alia*, an arrangement for controlling an electronic

device, said arrangement comprising an input unit with an optical scanner for recording images, and a signal processing unit for identifying predetermined information in at least one of the images and for controlling the electronic device dependent upon the predetermined information. While *Olschafskie et al.* provides for the ability for the user, using control buttons 24, to switch modes of the scanner from a character scanning mode to a microphone mode, it is respectfully submitted that there is no teaching or suggestion in *Olschafskie et al.* that is directed to identifying predetermined information in at least one of the images. Further, there is no teaching or suggestion in *Olschafskie et al.* that is directed to controlling the electronic device dependent upon the predetermined information in at least one of the images.

Further, based upon the discussion set forth above with regard to the teachings of *Faulkerson*, Applicants respectfully submit that *Faulkerson* fails to cure the deficiencies of the teachings of *Olschafskie et al.* as *Faulkerson* fails to teach or suggest identifying predetermined information in at least one of the images and further fails to teach controlling the electronic device dependent upon the predetermined information in at least one of the images. For at least this reason, it is respectfully submitted that as neither of the references teach or suggest this claim element, either alone or in combination, assuming these references are combinable, which Applicants do not admit, the Examiner has failed

to satisfy her burden to establish *prima facie* obviousness under 35 U.S.C. § 103.

In addition to the above argument, Applicants maintain that neither of the references teach or suggest wherein the input unit in a first function mode is arranged to convert the at least one image to a current text string containing a sequence of characters, and that the signal processing unit is arranged to control the electronic device on the basis of the current text string as set forth in claim 1. First, Applicants cannot ascertain from the outstanding Official Action which reference the Examiner is relying upon to teach this claim element. While the Examiner asserts that *Olschafskie et al.* teaches this claim element, the Examiner fails to provide any citation in the *Olschafskie et al.* reference to support this assertion.

Further, in the same rejection, the Examiner asserts that *Olschafskie et al.* fails to teach this claim element and asserts that *Faulkerson* cures the deficiencies of the teachings of *Olschafskie et al.* Should the Examiner maintain her rejection of claim 1 based upon the cited references, Applicants respectfully request the Examiner provide a detailed explanation as to which reference and which portion of the reference the Examiner is relying upon to teach or suggest this claim element in a non-final Official Action so that the Applicants may adequately respond to this rejection.

Second, it is respectfully submitted that neither of these references teach or suggest this claim element as set forth in claim 1. There is no teaching or suggestion in *Olschafskie et al.* that is directed to a signal processing unit being arranged to control an electronic device on the basis of the current text string converted from at least one image. Further, based upon Applicants' explanation of the teachings of *Faulkerson* set forth above, *Faulkerson* fails to teach or suggest this claim element. *Faulkerson* discloses the user's pressing of a function key to select one of the two functional modes. There is no teaching or suggestion in *Faulkerson* that is directed to a signal processing unit being arranged to control the electronic device on the basis of the current text string converted from the at least one image. As neither of the references, either alone or in combination, assuming these references are combinable, which Applicants do not admit, teach or suggest this claim element, it is respectfully submitted that the Examiner has failed to satisfy her burden in establishing *prima facie* obviousness under 35 U.S.C. § 103. As such, it is respectfully requested that the outstanding rejection be withdrawn.

Third, it is respectfully submitted that the Examiner has failed to provide proper motivation to combine the teachings of the references. In asserting her rejection of claim 1, the Examiner concludes it would have been obvious to one of ordinary skill in

the art at the time of the invention to have modified *Olschafskie et al.* to include an input unit with a first function mode arranged to convert at least one image to a current text string containing a sequence of characters. However, this does not appear to be the purported combination that the Examiner is making. Based upon Applicants' understanding of the Examiner's rejection, the Examiner appears to rely on *Faulkerson* to teach controlling the electronic device on the basis of the current text string. The Examiner makes no statement as to how it would have been obvious to one of ordinary skill in the art to combine the teachings of *Faulkerson*, namely, controlling the electronic device on the basis of the current text string (which Applicants maintain *Faulkerson* fails to teach), with the teachings of *Olschafskie et al.* The Examiner's statement that *Faulkerson* teaches providing a single apparatus for providing a dual function of OCR scanning in a computer mouse operation is insufficient to establish proper motivation directed to controlling an electronic device on the basis of a current text string. As the Examiner has failed to provide proper motivation to combine the teachings of the references, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103. As such, and for all of the reasons set forth above, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2-21 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1. It is further respectfully submitted that claim 22 contains elements similar to those discussed above with regard to claim 1, and thus claim 22, together with claims dependent thereon, are allowable for the reasons set forth above with regard to claim 1.


Conclusion


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #29,491
Michael K. Mutter, #29,680


MKM/CMV/jdm
4830-0112PUS1

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment(s): Replacement drawings for Figs. 1 and 2
Verified Translation of Specification